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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,854	01/11/2005	John Alan Gervais	PU020335	2672
24498	7590	01/08/2009		
Robert D. Shedd Thomson Licensing LLC PO Box 5312 PRINCETON, NJ 08543-5312			EXAMINER KIM, TAE K	
			ART UNIT 2453	PAPER NUMBER
			MAIL DATE 01/08/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,854

Applicant(s)

GERVAIS ET AL.

Examiner

TAE K. KIM

Art Unit

2453

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 11-14, 16-18 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 11-14, 16-18, and 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statements(s) (PTO/SB08)
Paper No(s)/Mail Date 10/08/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to the Applicant's response filed on October 10, 2008. No claims have been cancelled, amended, or added by the Applicant. Claims 1, 2, 4, 11 – 14, 16 – 18, and 21 – 31, where Claims 1 and 16 are in independent form, are presented for examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on October 10, 2008 was filed after the mailing date of the U.S. Application on January 11, 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

With regards to the objections made to Claims 23, 25, 29, and 31, examiner has withdrawn the objection. The aforementioned dependent claims further limit the scope of their respective preceding claims.

Response to Arguments

Applicant's arguments filed on October 10, 2008 have been fully considered but they are moot based on the new grounds of rejection as stated below after reconsideration of the claims based upon Applicant's remarks.

Based on the new grounds of rejection under Section 112, this is a non-final action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not contain subject matter describing the limitation of "comparing...a particular one compatibility parameter of said ALG file with both a compatibility feature of said bi-directional communication device and a non-signature, non-code-error checking feature expected in received and authentic ALG files."

Most notably, the specification states that after the compatibility feature of the communication device is compared to the particular one compatibility parameter of the ALG file, other parameters are checked for validity [See Fig. 3 of Specification; Items 312, 314, 316 - 340]. Additionally, the header size varies in its size and, therefore is not a feature expected in received and authenticated files. Furthermore, the header size is not compared to a non-signature, non-code-error checking feature expected in received and authentic ALG files [See Pg. 11, lines 3-6].

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "a favorable comparison of said *at least one compatibility parameter*" in the claim where "a compatibility feature" and "a particular

one compatibility parameter" are disclosed. There is insufficient antecedent basis for this limitation in the claim.

Claims 1, 2, 4, 11, 12, 14, 16 – 18, and 21 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,986,133 B2, invented by Michael D. O'Brien et al. (hereinafter "O'Brien"), in view of U.S. Appl. 2002/0152399, filed by Gregory J. Smith (hereinafter "Smith").

2. Regarding Claims 1, 4, 14, 16, and 27, O'Brien discloses a system and method of receiving, at a bi-directional communications device [Fig. 2; Col. 6, Lines 34-55; agent fetches file from the server], an application level gateway (ALG) file [Fig. 1; Col. 4, Lines 22-25; bi-directional device can be another server or any other interconnect system, also called a gateway];

comparing, at the bi-directional communications device, a particular one compatibility parameter of said ALG file with a compatibility feature of said bi-directional communications device [Col. 5, Lines 55-58; Col. 12; Lines 48-54; upgrade policy defining which IP address or hostname of the server will provide updates and the "serverName" component parameter specifying the IP address or host name of the server the agent will inquire about the update]; and

storing said ALG file at said bi-directional communications device in response to a favorable comparison of said at least one compatibility parameter [Col. 5, Lines 55-58; Col. 12; Lines 48-54; if the "serverName" component parameter matches the IP address or hostname of the server carrying the particular updates match, the upgrade process will start and the agent will download the upgrade].

O'Brien does not specifically disclose that the particular one compatibility parameter of the file is also compared with a non-signature, non-code-error checking feature expected in received and authentic files.

Smith discloses of a method and system for providing protection from exploits to devices connected to a network by comparing the received file with a non-signature, non-code-error checking feature expected in received and authentic files [Para. 0065 and 0066; the size of the header or body of the file is examined to determine if they are longer then they should be]. It would have been obvious to one skilled in the art at the time of the invention to verify the header or body length of a particular message to ensure that there is no executable code within the overflow buffers allotted for portions or all of a header or body of a file [Para. 0026]. This allows the system to prevent improper access to data or unauthorized programs executed on the host computer [Para. 0026].

4. Regarding Claims 2 and 17, O'Brien, in view of Smith, discloses all the limitations of Claims 1 and 16 above. O'Brien further discloses of rejecting the ALG file at the communications device in response to an unfavorable comparison of said particular one compatibility parameter [Col. 5, Lines 27-30, 32-34; upgrade policies allow system administrators to determine which target devices will or will not receive a specific upgrade].

5. Regarding Claims 11 and 18, O'Brien, in view of Smith, discloses all the limitations of Claims 1 and 16 above. O'Brien discloses several types of bi-directional devices that can implement the disclosed system and method [Fig. 1; Col. 4, Lines 23-

26; devices can be a monitor, printer, copier, cell phone, PDA, server, etc.]. However, O'Brien or Smith does not specifically disclose that the bi-directional communication device is a cable modem.

Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, i.e. cable modem is a bi-directional communication device, are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

6. Regarding Claim 12, O'Brien, in view of Smith, discloses all the limitations of Claim 1 above. O'Brien further discloses that the system periodically polls a service provider to determine if at least one of a new and updated ALG file is available, then sends a request for an available ALG file and receives said requested ALG file from an access network [Col. 4, Lines 28-30, 56-59; agent polls the server for updates and, if an update is available, fetches and applies the update to the device].

7. Regarding Claims 21 – 23, 26, 28, 29, O'Brien, in view of Smith, discloses all the limitations of Claims 1, 4, 16, and 27 above. O'Brien further discloses that at least one compatibility feature of said bi-directional communications device comprises an amount of available memory in said bi-directional communications device to store the ALG file [Fig. 2; Col. 7, Lines 15-21; upgrade agent in the firewall fetches all chunks of the

upgrade file and rebuilds the file before the agent performs a security check; Col. 10, Line 33 - Col. 11, Line 59; the InMemCapacity parameter requires that the bi-directional device has at least this amount of memory available to fetch all chunks of the upgrade and to rebuild the file].

8. Regarding Claims 24, 25, 30, and 31, O'Brien, in view of Smith, discloses all the limitations of Claims 1 and 16 above. O'Brien further discloses that a value of the particular one compatibility parameter of said ALG file is added to a value of another particular one compatibility parameter of said ALG file as a sum that is compared to a value of the compatibility feature of said bi-directional communications device [Col. 7, Lines 15-18; the upgrade agent performs a comparison for each chunk of the upgrade with the appropriate checksum to determine if the file is corrupt].

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien, in view of Smith, and further in view of U.S. Patent 6,031,830, invented by Paul A. Cowen (hereinafter referenced as "Cowen").

9. Regarding Claim 13, O'Brien, in view of Smith, discloses all the limitations of Claim 1 as stated above. O'Brien or Smith, however, do not specifically disclose that the request to download the files occurs after a configuration file is identifying at least one new or updated ALG file is received and first compared by the device.

Cowan discloses a system and method of downloading new or updated files where the device receives a configuration file from said service provider, which identifies at least one new or updated ALG files, then the devices sends a request for those files, and receives the requested files from an access network (Figs. 7(a) – (h);

Col. 10, Lines 27 – Col. 11, Line 54; terminal requests query to host/server, which in turn sends a package definition packet identifying the file; terminal then compares versions and if they are different, terminal transmits the file request packet and the host/server begins transmitting file data). It would be obvious to one skilled in the art at the time of the invention to verify that the files are new or updated before downloading them into the terminal. Not only will that save resources that would have been used if the files are downloaded and then verified, but it also prevents the terminal from accidentally deleting the prior version of the files prior to completing the download of the new or updated files.

Conclusion

The examiner points out that the pending claims must be "given the broadest reasonable interpretation consistent with the specification" [In re Prater, 162 USPQ 541 (CCPA 1969)] and "consistent with the interpretation that those skilled in the art would reach" [In re Cortright, 49 USPQ2d 1464 (Fed. Cir. 1999)].

Examiner's Note: Examiner has cited particular figures, columns, line numbers, and/or paragraphs in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae K. Kim, whose telephone number is (571) 270-1979. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on (571) 272-4001. The fax phone number for submitting all Official communications is (703) 872-9306. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the examiner at (571) 270-2979.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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/ARIO ETIENNE/

Supervisory Patent Examiner, Art Unit 2457